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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,049	07/30/2003	James A. Truc	82800ADAN	8183

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EXAMINER

GRAY, DAVID M

ART UNIT PAPER NUMBER

2851

DATE MAILED: 03/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/630,049

Applicant(s)

TRUC ET AL.

Examiner

David M Gray

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/30/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kahle in view of Kraft et al.

Kahle discloses a method and apparatus for printing a disk label for a CD. The label is applied to or printed on the surface of the CD opposite the data-recording surface. Kahle discloses printing the label when the CD is created in order to insure that the label correctly corresponds to the data written into the data-recording surface of the CD. Kahle teaches it is important to label the disks adequately. And Kahle teaches that by immediately printing the label indicating the contents the product quality and integrity is improved.

Kahle differs from the claimed invention in that Kahle does not specifically disclose that the label contains a plurality of positive images corresponding to the digitized photographic images stored on the data-recording surface.

Kraft et al. teaches that the "index print is thus a kind of "table of contents" of a photo album and is especially advantageous and customer-friendly for ordering reprints", col 2, lns 5-17. Kraft et al. additionally teaches that additional data such as frame number and date can be provided on the image of the index print, see col 19, lns 13-33.

It would have been obvious to one of ordinary skill at the time of applicant's invention to provide an index print as a label for a disk created by Kahle, such as a photo CD, having

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photographic images stored thereon. Such an index print label would be the table of contents for the disk as taught by Kraft et al. One would have been motivated to so modify Kahle in order to allow a user of the disk to readily identify the photographic images stored thereon.

The specific layouts of the positive images claimed by applicant are merely related to design choice of printed matter and do not set forth any unobvious structural indicia relationship.

Claims 8-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otake et al., Ishikawa et al. and Wess.

Otake et al. discloses several image recording mediums including a video disc. The Otake et al. disclosure teaches that it is a long and laborious process to ascertain the contents of such a recording medium which stores photographic images as electronic signals, see column 1, lines 31-41. In order to solve this problem Otake et al. teaches providing an index print which catalogs the images thus stored, see column 2, lines 5-8. Otake et al. differs from the claimed invention in that the index print is provided separately from the image recording medium.

Ishikawa et al. teaches the equivalence of applying an index print either by printing directly on the item or by affixing an adhesive label with the index print thereon.

The Wess reference specifically refers to the Otake et al. patent, see column 1, lines 18-54. Wess teaches that while the index print of Otake et al. affords the ability to readily identify the contents of an image recording medium, the index print can become separated from the recording medium. Wess teaches that in order to solve this problem the index print is directly affixed to the recording medium, see column 2, lines 1-7.

It would have been obvious to one of ordinary skill in the art, at the time of appellant's invention, to provide the video disc recording medium of Otake et al. with an index print attached directly thereto. One would have been motivated to so modify Otake et al. for the benefit of alleviating the "fear that the index print will become separated from the image recording medium" as taught by Wess. The index print could be applied by printing directly or by applying a label as taught by Ishikawa et al.

Regarding the claimed "photographic images represented by the digital image data stored on the first surface of the digital image storage disk are not readable by a human", such well known disc structure is met by Otake et al. Otake et al. state, "an image regenerating apparatus is used to read out a signal recorded on the image recording medium", column 1, lines 35-36. Such an image regenerating apparatus is necessary because the image is not human readable.

Regarding the claimed "providing, on a second surface of the digital image storage disk, positive images", it is standard and necessary to provide the CD label on the surface opposite to the data-recording surface. The data-recording surface must be unobstructed in order for the digital data to be read by the optical reader.

Regarding the specific layouts of the positive images set forth in the outstanding claims, these limitations are merely design choice of printed matter that do not set forth any unobvious indicia structural relationship.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

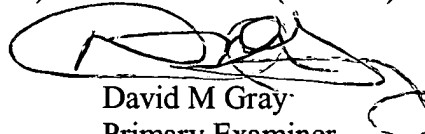
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The Ewalt, Wen et al. (5,781,221), DeBoer et al. and Wen et al. (6,019,151) references are cited for their disclosure of printing labels onto CD's in order to identify the contents thereof, and for their disclosure of the structural relationship of the printed labels to the CD.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M Gray whose telephone number is 571-272-2219. The examiner can normally be reached on M-T & T-F 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Russ Adams can be reached on 571-272-2112. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David M Gray
Primary Examiner
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